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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/820,846      | 03/30/2001  | Ko Onodera           | 205386US-2          | 7023             |

22850 7590 07/18/2003

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| EXAMINER |
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TALBOT, BRIAN K

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| ART UNIT | PAPER NUMBER |
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1762

DATE MAILED: 07/18/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,846

Applicant(s)

ONODERA ET AL.

Examiner

Brian K Talbot

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 6-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/14/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1762

1. The amendment filed 5/14/03 has been considered and entered. Claims 1-15 remain in the application.
2. This application contains claims 6-15 drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
3. The proposed drawing corrections have been noted and approved.

***Claim Rejections - 35 USC § 102***

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Minowa et al. (5,622,585).

Minowa et al. (5,622,585) depicts an alignment holder (25) where parts to be coated (1,3) are placed and held together by adhesive strip (23a). The combination is pressed to a coating material (30) to coat one end and then the coated end is attached by a second adhesive strip (23b) and the first adhesive strip (23a) is removed. The second end is coated while the combination is held by adhesive strip (23b) (col. 5, line 15 – col. 5, line 40). A capacitor is formed with the terminal ends being coated (Fig. 10).

***Claim Rejections - 35 USC § 103***

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nitta et al. (4,664,943) in combination with JP 11-334785A or Minowa et al. (5,622,585).

Nitta et al. (4,664,943) teaches a method of coating external electrodes for chip parts. The apparatus includes a aligning means to align the chip parts to be coated by contacting the terminal ends to the coating material and reversing the chip to thereby coat the other terminal side.

Nitta et al. (4,664,943) fails to teach using an adhesive coating to hold the chip part for coating the terminal ends.

JP 11-334785A and Minowa et al. (5,622,585) teach an adhesive tape atop a base material for carrying and mounting electronic parts.

Therefore, it would have been obvious for one skilled in the art at the time the invention was made to have substituted one holding mechanism for another, an adhesive tape as evidenced by JP 11-334785A or Minowa et al. (5,622,585) for the holding plates of Nitta et al. (4,664,943), for holding the chip parts during coating the terminal ends with the expectation of achieving similar results.

***Response to Amendment***

4. Applicant's arguments filed 5/14/03 have been fully considered but they are not persuasive.

Art Unit: 1762

Applicant argued that the prior art fails to teach the claimed invention in the fact that the adhesive would have to be removed from the plate-like body which would necessitate cleaning of the plate-like body.

The Examiner disagrees. The claims are not commensurate in scope with the claims. In addition, the prior art teaches utilizing an adhesive strip to hold one end of a electronic component while coating the other end and continuing this process for the coating of the second end.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1762

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K Talbot whose telephone number is (703) 305-3775. The examiner can normally be reached on Monday-Friday 6AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3775.



Brian K Talbot  
Primary Examiner  
Art Unit 1762

BKT  
July 17, 2003